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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,862	09/28/2000	Volker Schuren	324501-765	9465

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EXAMINER

TAMAI, KARL I

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 07/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/672,862

Applicant(s)

SCHUREN, VOLKER

Examiner

Tamai IE Karl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s)    is/are withdrawn from consideration.
- 5) ☐ Claim(s)    is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s)    is/are objected to.
- 8) ☐ Claim(s)    are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on    is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on    is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No.   .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s)   .
- 4) ☐ Interview Summary (PTO-413) Paper No(s).   .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:   .

## **DETAILED ACTION**

### ***Specification***

1. The new title of the invention has been entered into the file wrapper. The requirement of a new title is withdrawn.

### ***Drawings***

2. The objection to the drawings is withdrawn.
3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 4/24/02 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shioda et al.(Shioda)(JP 10-277,707) and Snider et al.(Snider)(US 5,861,689). Shioda teaches a stator with a laminated core with a three phase winding in a plurality of slots with a shield including a conductive layer 5 between the winding 3 and the laminated core with an insulation layer 4 between the shield and the core, and an insulation layer

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25, 26 between the shield and the winding. The shield being grounded to the core through the insulation 25, 26, it is inherent that the structure reduces capacitive currents in the stator. Shioda teaches every aspect of the invention except the coil grounded only on the current fed side of the winding and a shaft. Snider teaches the stator grounded on the same side as the stator windings and a motor shaft 30. It would have been obvious to a person of ordinary skill in the art at the time of the invention to construct the motor of Shioda with the winding shield grounded on the same side as the stator terminals to simplify electrical connections to the motor as in Snider, and with the shaft of Shioda to provide rotary output from the machine.

### ***Response to Arguments***

6. Applicant's arguments filed 4/24/02 have been fully considered but they are not persuasive. The Applicant's argument the inventions are for different stated purposes is not persuasive. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The structure of Shioda is the same as claimed by the applicant: and therefore the benefit of reducing electrostatic discharge through the bearings is an incidental benefit conferred by the structure, even though it is not specifically set forth by Shioda. The Applicant's argument regarding damage to the bearings is not persuasive because the limitation is not claimed; the Applicant has not even claimed bearings. The Applicant's argument regarding Snider is not persuasive.

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Snider is relied upon for the teaching of the ground connection being on the same side at the winding terminals. Snider teaches this is done to integrate a ground terminal with the winding terminals to simplify production and reduce costs. Therefore the combined teaches of Shidoa and Snider teaches a conductive shield insulated from both the core and the coil (Shidoa) which is grounded on the same side as the motor terminals (Snider) to simplify production and costs. The rejection is proper and maintained.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl I.E. Tamai whose telephone number is (703) 305-7066.

The examiner can be normally contacted on Monday through Friday from 8:00 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nestor Ramirez, can be reached at (703)308-1371. The facsimile number for the Group is (703)305-3432.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at (703) 308-0956.

Karl I Tamai  
PRIMARY PATENT EXAMINER  
July 17, 2002



KARL TAMAI  
PRIMARY EXAMINER